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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,907	10/03/2005	Mikio Fukuda	SAIT-4396	6244
5409 7590 09/26/2008 SCHMEISER, OLSEN & WAITTS 22 CENTURY HILL DRIVE SUITE 302 LATHAM, NY 12110				
EXAMINER JAMAL, ALEXANDER				
ART UNIT 2614		PAPER NUMBER		
MAIL DATE 09/26/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,907

Applicant(s)

FUKUDA ET AL.

Examiner

ALEXANDER JAMAL

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the:

-DC jack of **claim 2**

-The speech sending opening and speaker arrangement (enabling the moving of the speaker) of **claims 7,8,17**

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 7,8,17** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite that the bone conduction speaker can move longitudinally or spherically within the enclosure. It is not disclosed how this would be implemented in the specifications or drawings. Clarification or correction is requested.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-17**, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims all recite a connection cord with a connector that is connected to the

speaker and microphone. It is not clear exactly how the cord is connected, or exactly how it gets the power to the amplifier. For the purpose of examination, the examiner assumes the cord is coupled in such a manner as to couple sounds to the speaker and from the microphone (as in any standard telephone handset).

As per **claim 2**, the claim recites a DC jack that receives a DC plug. It is not clear what this jack is or where it is situated as it is not shown in the drawings. For the purpose of examination, the examiner assumes the plug is a well known, standard AC/DC adaptor power cord that couples from the wall outlet to the telephone using a DC jack and plug (which are inherently required to transfer the power to the device).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6,9-16 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6728374 in view of Thomke et al (4817138).

As per application **claim 1**, patent claim 1 recites a telephone handset with a bone conduction speaker but does not specify the amplifier, AC/DC adaptor to supply power (via a cord) and an additional cord to couple the handset to the rest of the telephone system.

Thomke teaches a telephone handset comprising an enclosure (Fig. 1) for the enclosed speaker, an amplifier (inherent to speech circuitry 80 in Fig. 3 to drive the speaker, and AC/DC adaptor, and a cord to couple the phone to the phoneline, and a cord to couple a second handset to the main body-handset (fig.1).

The examiner contends it would have been obvious to implement an enclosure for the purpose of supporting/protecting the claimed handset (inherent to enclosures), an amplifier to drive the output signal to the speaker, and the disclosed cabling connection for the purpose of coupling the disclosed functional components (such as the AC/DC adaptor and the handset circuitry).

As per **claims 2,3**, it would have been obvious to provide the means (such as a jack and plug) to couple the AC adaptor to an AC power source and to the phone for the purpose powering the phone.

As per **claims 4,9,10**, the phone comprises an on-off actuation switch implemented with button 56 (Fig. 1). This switch will provide or remove power from the device (including the transmit/receive amplifiers).

As per **claim 5**, the on/off switch is actuated by the handset being rested on the base/handset.

As per **claims 6,11,12,13,14,15,16**, the speaker of the phone system of Thomke is exposed to the outside via a grill in the enclosure (fig. 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-6,9-16** rejected under 35 U.S.C. 103(a) as being unpatentable over Thomke et al (4817138), and further in view of applicant's admitted prior art (specification).

As per **claim 1**, Thomke discloses a phone (inherently comprising a transmitter/receiver) comprising a handset and a base that is also a handset. Both handsets have openings for a microphone and speaker (Fig. 1). The handset comprises casing 28 (Fig 1) that contains speech circuit 80 (Fig. 3) which inherently comprises transmit/receive amplifiers for the purpose of driving the speakers and amplifying the received signals from the microphones. The device may be configured with a secondary

handset that contains the microphone, speaker, and transmit/receive circuitry (which inherently comprises amplifiers) (Col 9 lines 30-40). The handset further comprises an AC adaptor (AC/DC converter) with a cord and connection to the mains (a standard AC power outlet) with a further cord going to the base unit. The 'cord connecting the amplifier to the AC adaptor' as per applicant's claims, may be read as the cord coming from the mains to the secondary handset, or the additional disclosed cord from the handset to the handset/base unit providing power to the speech circuit (which also comprises amplifiers for the microphone/speaker). The phone comprises a cord 10 (Fig. 1) from a handset to a main body, and also cord 4 with plug 6 that may fit into a 'telephone main body'. The examiner reads a telephone main body as any network component into which a handset plugs into. However, Thomke does not disclose a bone conduction speaker used in either handset speaker.

Applicant's admitted prior art (background section) discloses that bone conduction speakers used in phone handsets are well known in the art and comprise the advantage of the user being able to hear the incoming sounds more clearly in noisy environments. It would have been obvious to one of ordinary skill in the art at the time of this application to implement a bone conduction speaker with the speech circuit driving circuitry of Thomke for the advantage of improved hearing in noisy environments.

As per **claims 2,3**, the disclosed AC/DC adaptor inherently comprises a DC jack (DC interface, such as a wall outlet). The plug would be coupled to the jack in 'an insertion manner' in the same way as a standard AC/DC converter.

As per **claims 4,9,10**, the phone comprises an on-off actuation switch implemented with button 56 (Fig. 1). This switch will provide or remove power from the device (including the transmit/receive amplifiers).

As per **claim 5**, the on/off switch is actuated by the handset being rested on the base/handset.

As per **claims 6,11,12,13,14,15,16**, the speaker of the phone system of Thomke is exposed to the outside via a grill in the enclosure (fig. 1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 571-272-7498. The examiner can normally be reached on M-F 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 571-272-7499. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and **571-273-8300** for After Final communications.

/Alexander Jamal/

Primary Examiner, Art Unit 2614

Examiner Alexander Jamal

September 27, 2008

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